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(For Requester #3)

In re reissue application of
Dickens
Serial No. 09/512,592 ✓
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

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REEXAM UNIT

In re Dickens
Reexamination Proceeding
Control No. 90/005,592
Filed: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,628
Filed: February 2, 2000
For: U.S. Patent No. 5,806,063

DECISION, SUA SPONTE,
TO MERGE REEXAMINATION
AND REISSUE PROCEEDINGS

In re Dickens
Reexamination Proceeding
Control No. 90/005,727
Filed: May 16, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/006,541
Filed: February 2, 2003
For: U.S. Patent No. 5,806,063

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,806,063 issued to Bruce M. Dickens on September 8, 1998, and a certificate of correction issued in the '063 patent on November 30, 1998.
2. The Commissioner of the USPTO ordered, on his own initiative, reexamination of the '063 patent on December 21, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,592.
3. On February 2, 2000, a third party requester (requester #1), Paul E. Crawford, filed a request for reexamination, and the request was assigned Control No. 90/005,628.
4. On February 18, 2000, patent owner filed in the '5592 proceeding, a statement under 37 CFR § 1.530 in response to the Commissioner's order for reexamination.
5. On February 23, 2000, patent owner filed a reissue application which was assigned Application No. 09/512,592.
6. Reexamination was ordered in the '5628 proceeding on March 10, 2000.
7. On May 16, 2000, a third party requester (requester #2), Ross F. Hunt, Jr., filed a request for reexamination, and the request was assigned Control No. 90/005,727.
8. Reexamination was ordered in the '5727 proceeding on August 10, 2000.
9. On October 10, 2000, patent owner filed in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000.
10. A requester's reply under 37 CFR § 1.535 was not received from requester #2, and the time for filing same has expired.

11. Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592 were merged in a decision mailed on November 6, 2000.
12. A housekeeping amendment was filed in the 4 merged proceedings on January 5, 2001, placing the same claims in all 4 cases.
13. On February 7, 2003, a third party requester (requester #3), Stanley B. Green, filed a request for reexamination, and the request was assigned Control No. 90/006,541.
14. Prosecution ensued and a final rejection was mailed in the 4 merged proceedings on April 16, 2003.
15. On April 21, 2003, reexamination was ordered in the '6541 proceeding.
16. A Notice of Appeal was filed in the 4 merged proceedings on August 11, 2003.
17. On October 15, 2003, a Request for Continued Examination (RCE) was filed, along with the fee, a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the 4 merged proceedings.

DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d) :

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the four reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6541 reexamination proceeding, and a response to the outstanding Office action has been filed in the 4 merged proceedings (Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592), a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of

expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the files shows that (a) the '6541 reexamination has been ordered and is awaiting a first Office action by the examiner and (b) the '5592, '5628, and '5727 reexaminations are merged with the reissue Application No. 09/512,592, and a response to the outstanding rejection was received, and the 4 merged proceedings are awaiting the next Office action. More specifically, on October 15, 2003 a Request for Continued Examination (RCE) was filed, along with a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the merged proceeding. Also, the original patent abstract has been amended. Further, in addition to the original unamended patent claims 1-9 and 11-15 in the merged proceeding, applicant/patent owner has amended original patent claim 10, and submitted new claims 16-76 for consideration. In the '6541 reexamination proceeding, no amendments have been filed.

Accordingly, the specification, abstract and claims are not identical in all five proceedings. In order to provide efficient and prompt handling of all five proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue application and the four reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the first, second, third and fourth reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

In accordance with 37 C.F.R. 1.565 § , the above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The patent owner is required to maintain identical amendments in the reissue application and four reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all five files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within ONE (1)

MONTH of this decision placing the same amendments in all five cases, specifically, Application No. 09/512,592, and Control Numbers 90/005,592, 90/005,628, 90/005,727 and 90/006,541. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at 2 months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the four reexamination proceedings. Each action will contain identifying data for all of the cases, i.e., the reissue application and the four reexamination proceedings. Each action will be physically entered into all five files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with five copies being filed for entry in the five files, with each of the five bearing a signature. Any such responses must be served on the requesters, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding as to the reissue application, and continue examination as to the four reexamination proceedings.

that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

Copies of all Office actions must be provided by the Office to all of the third party requesters. Further, any paper filed by the patent owner/applicant in the merged reissue/reexamination proceeding must be served on all of the third party requesters.

If a final rejection is mailed, the patent owner/applicant may then file "after-final" submissions (e.g., amendment-after-final, affidavit(s), notice of appeal), all as appropriate to patent owner's situation and they will be dealt with as they are dealt with in a reissue application that is not merged.

CONCLUSION

1. The above-identified reissue application and first, second, third and fourth reexamination proceedings ARE MERGED into a single consolidated proceeding.
2. A copy of this decision will be placed into each of the five files.
3. The reissue application file and the four reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.
4. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in all five cases of the present merged proceeding.
5. The examiner should issue an Office action for the present merged proceeding of the reissue application and the four

reexamination proceedings **after** the following events have occurred:

The earlier of

- (a) the submission of the housekeeping amendment to place the same amendments in both cases, or
- (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

6. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in all five files will result in the Office's rejection of any claim that does not contain identical text in all five merged proceedings under 35 U.S.C. 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.
7. All further examination should be conducted in accordance with Parts II and III of this decision.
8. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.


Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration